

REMARKS

Claims 1 and 20-51 have been cancelled without prejudice.

Claim 52 was added. In light of the cancellation of claim 1, claims 3-4 and 8-12 have been amended to depend from independent claim 52. Support for these claims can be found throughout the specification including, for example, ¶¶ 0014-0017, 0024-0027, 0053-0060, 0127-132; in the Examples (¶ 0134), and in original claims 1-4, 8-12, 20, 28-30.

Claims 8-10 have been amended to replace the term "at least about . . . or less" with the term "less than or equal to about" This amendment is made exclusively for clarity and does not change the scope of the claims in any way.

Claims 12-15 have been amended to replace the term "no more than about" with the term "less than or equal to about" This amendment is made exclusively for clarity and does not change the scope of the claims in any way.

Applicant submits that no new matter has been added via these claims.

Objection to the Claims

Claims 1 and 47 have been objected to for "being identical duplicates of each other. . . ." (Paper No. 20071116 at 3.) Claims 1 and 47 have been cancelled without prejudice. Accordingly, the objection has been rendered moot and withdrawal is requested.

35 U.S.C. § 112, ¶ 2

Claims 1 and 47 were rejected as indefinite. Claims 1 and 47 have been cancelled without prejudice. Accordingly, the rejection of these claims has been rendered moot and withdrawal is requested.

Claims 12-15, 35, 37, 50 have been rejected as indefinite because in the view of the Patent Office the term "no

more than about" renders the claims unclear. (Paper No. 20071116 at 6.) Claims 12-15 have been amended to replace the term "no more than about" with the term "less than or equal to about." See M.P.E.P. § 2173.05(b)(A) citing *W.L. Gore & Accos. v. Garlock, Inc.*, 721, F.2d 1540 (Federal. Cir. 1983) (The term "'exceeding about 10% per second' is definite because infringement could clearly be assessed through the use of a stopwatch."). In addition, claims 35, 37, and 50 have been cancelled without prejudice. Accordingly, this ground of rejection has been rendered moot and should be withdrawn.

Claims 21, 32, 48, and 50 have been rejected as indefinite because in the view of the Patent Office the term "between about" renders the claims unclear. (Paper No. 20071116 at 6.) Claims 21, 32, 48, and 50 have been cancelled without prejudice. Accordingly, the rejection of these claims has been rendered moot and withdrawal is requested.

Claims 35, 37, and 50 have been rejected as indefinite because in the view of the Patent Office the term "no less than about" renders the claims unclear. (Paper No. 20071116 at 6.) Claims 35, 37, and 50 have been cancelled without prejudice. Accordingly, the rejection of these claims has been rendered moot and withdrawal is requested.

Claims 8-10, 22-23, 33-34, and 49 have been rejected as indefinite because in the view of the Patent Office the term "at least about . . . or less" renders the claims unclear. (Paper No. 20071116 at 6-7.) Claims 8-10 have been amended to replace the term "at least about . . . or less" with the term "less than or equal to about" See M.P.E.P. § 2173.05(d) citing *In re Kirsch*, 498 F.2d 1389 (C.C.P.A. 1974) (The term "less than 7 mole percent" is definite, despite appearing to be open-ended, because "the overall meaning of the claim" should not be distorted."). In addition, claims 22-23, 33-34, and 49

have been cancelled without prejudice. Accordingly, this ground of rejection has been rendered moot and should be withdrawn.

35 U.S.C. § 102(a)

Claims 1, 3-30, 32-36, and 47-51 have been rejected as anticipated by Yang *et al.*, U.S. Patent Application Publication 2004/0120915 ("Yang"). (Paper No. 20071116 at 7)

Yang discloses "surface cleaning and protection compositions . . . [including] polyhedral oligomeric silsesquioxane (POSS)." (Abstract.) Yang discloses various POSS compounds. (See ¶¶ 0015-0107.)

Claims 1 and 20-30, 32-36, and 47-51 have been cancelled without prejudice. The remaining rejected dependent claims have been amended to depend, directly or indirectly, from added claim 52. Claim 52 requires that the "at least one POSS . . . is octa(phenyl)octasilsesquioxane."

Yang, however, does not disclose a compositions containing octa(phenyl)octasilsesquioxane. Accordingly, the rejection has been rendered moot and withdrawal is requested.

35 U.S.C. § 103(a)

Claims 31 and 37-38 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Yang in view of Lichtenhan *et al.*, U.S. Patent 6,660,823 ("Lichtenhan"). (Paper No. 20071116 at 14.) Claims 31 and 37-38 have been cancelled without prejudice. Accordingly, the rejection has been rendered moot and withdrawal is requested.

Claims 1, 3-42, and 47-51 have been rejected under 35 U.S.C. § 103(a) as unpatentable over LeGrow *et al.*, U.S. Patent 6,489,274 ("LeGrow") in view of Lichtenhan *et al.*, U.S. Patent 6,660,823 ("Lichtenhan") in further view of James *et al.*, U.S. Patent Application 2002/0128414 ("James") and further in view of Guichard *et al.*, U.S. Patent 6,491,981 ("Guichard"). (Paper No. 20071116 at 15.)

Claims 1 and 20-42 and 47-51 have been cancelled without prejudice. The remaining rejected dependent claims have been amended to depend, directly or indirectly, from added claim 52. Claim 52 requires that the "at least one POSS . . . is octa(phenyl)octasilsesquioxane."

None of *LeGrow*, *Lichtenhan*, *James*, or *Guichard*, either alone or in combination, discloses or suggests a composition containing octa(phenyl)octasilsesquioxane. Accordingly, the rejection has been rendered moot and withdrawal is requested.

Nonstatutory Obviousness-Type Double Patenting

Claims 1, 3-42, and 47-51 have been provisionally rejected for nonstatutory obviousness-type double patenting over U.S. Patent Application No. 10/790,280 ("281 Application") in view of *Yang*. (Paper No. 20071116 at 21.) Because the claims of the '281 Application have not yet issued, this provisional rejection may never mature. Should this rejection 1) be the sole remaining rejection in the instant application and 2) be appropriately maintained in the instant application¹, Applicant will at that time respond to the rejection, and if appropriate, offer a terminal disclaimer. Until such time, Applicant makes no comment or representation as to this rejection.

As it is believed that all of the objections and rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

¹ The instant application and the '281 Application were filed on the same day. An obviousness-type double patenting rejection is therefore appropriate in only one of the two applications. (See M.P.E.P. § 804(I)(B)(1) (8th Ed., Rev. 6, August 2007, p. 800-17).)

Application No.: 10/799,281

Docket No.: LOREAL 3.0-005 I

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: June 4, 2008

Respectfully submitted,

By 

Stephen J. Brown

Registration No.: 43,519

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

(908) 654-5000

Attorney for Applicant

LD-447\ 849701_1.DOC